

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 2-9, 11-22, and 24-31 are currently pending. Claims 2, 17, 30, and 31 have been amended; and Claims 10 and 23 have been canceled without prejudice by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 2, 17, 30, and 31 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 18, 26, and 56 of U.S. Patent No. 6,658,408 to Yano et al.; and Claims 2-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,982,370 to Kamper (hereinafter “the ‘370 patent”) in view of U.S. Patent No. 5,926,808 to Evans et al. (hereinafter “the ‘808 patent”).

Applicants respectfully submit that the double patenting rejection of Claims 2, 17, 30, and 31 is rendered moot by the terminal disclaimer filed herewith.

Amended Claim 2 is directed to a method of managing information, comprising: (1) identifying a word of an image as a keyword; (2) determining a search result corresponding to the keyword; (3) displaying, on a display unit, a pop-up menu prepared based on the search result; (4) displaying information corresponding to the search result; and (5) displaying additional information corresponding to a selection of a portion of the displayed information. Claim 2 has been amended to incorporate the limitations recited in dependent Claim 10. Accordingly, no new matter has been added. Moreover, Claim 10 has been canceled accordingly.

Regarding the rejection of Claim 2 under 35 U.S.C. § 103, the Office Action asserts that the '370 patent discloses everything in Claim 2 with the exception of the claimed "keyword displayed image," and relies on the '808 patent to remedy that deficiency.¹

Applicants respectfully submit that the rejection of Claim 2 (and dependent Claims 3-9 and 11-16) is rendered moot by the present amendment to Claim 2. Further, Applicants respectfully submit that the rejection of dependent Claim 10 is rendered moot by the present cancellation of that claim.

The '370 patent is directed to a search interface including a highlight tool used to identify search terms in an HTML document displayed on a web browser. The '370 patent discloses that upon selection of text, a pop-up menu appears that offers the user the option of performing a search based on the selected text. See Figs. 5c and 5f. Further, as shown in Figure 5h, the '370 patent discloses a system in which an optional pop-up window is displayed to allow the user to save links to web pages obtained by a search, without requiring the user to actually visit the website. However, Applicants respectfully submit that the '370 patent fails to disclose displaying, on a display unit, a pop-up menu prepared based on the search result. None of the pop-up menus disclosed by the '370 patent are prepared based on a search result, as recited in amended Claim 2.

The '808 patent is directed to a method and apparatus for displaying portions of text for multiple documents over multiple databases related to a search query. However, Applicants respectfully submit that the '808 patent fails to disclose displaying, on a display unit, a pop-up menu prepared based on a search result, as recited in amended Claim 2.

Accordingly, no matter how the teachings of the '370 and '808 patents are combined, the combination does not teach or suggest the step of displaying, on a display unit, a pop-up menu prepared based on a search result, as recited in amended Claim 2. Accordingly,

¹ See page 4 of the Office Action dated November 10, 2004.

Applicants respectfully submit that amended Claim 2 (and dependent Claims 3-9 and 11-16) patentably define over any proper combination of the '370 and '808 patents.

Independent Claims 17, 30, and 31 recite limitations analogous to the limitations recited in amended Claim 2. Moreover, Claims 17, 30, and 31 have been amended in a manner analogous to the amendment to Claim 2. Accordingly, for the reasons stated above for the patentability of Claim 2, Applicants respectfully submit that the rejections of Claims 17, 30, and 31 (and all associated dependent claims) are rendered moot by the present amendment to independent Claims 17, 30, and 31.

Thus, it is respectfully submitted that independent Claims 2, 17, 30, and 31 (and all associated dependent claims) patentably define over any proper combination of the '370 and '808 patents.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Kurt M. Berger
James J. Kulbaski
Registration No. 34,648
Attorney of Record
Kurt M. Berger, Ph.D.
Registration No. 51,461

JJK/KMB/jyh
I:\ATTY\KMB\240's\240117us\240117US-AMD 1.24.05.doc